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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,122	09/26/2003	Yuchi Ikeda	17057	1307
23389	7590	10/02/2006	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC			KASZTEJNA, MATTHEW JOHN	
400 GARDEN CITY PLAZA			ART UNIT	PAPER NUMBER
SUITE 300				
GARDEN CITY, NY 11530			3739	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

N1

Office Action Summary	Application No.	Applicant(s)	
	10/673,122	IKEDA ET AL.	
	Examiner	Art Unit	
	Matthew J. Kasztejna	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 July 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,8,9,15,16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,8,9,15,16,18-20 and 22-24 is/are rejected.
- 7) Claim(s) 21 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 September 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 17, 2006 has been entered.

Notice of Amendment

In response to the amendment filed on June 16, 2006, canceled claims 2-7, 10-14 and 17 are acknowledged. The objection to the drawings is *withdrawn*. The following new grounds of rejection are set forth:

Claim Objections

Claim 21 is objected to because of the following informalities: grammatical errors in line 2 of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 15, 16, 18-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,982,725 to Hibino et al.

In regards to claim 1, Hibino et al. disclose an electric bending endoscope comprising: a bending portion 508 arranged to an inserting portion 504; a first unit 663 which has a frame unit and which holds a motor 686 that generates driving force for bending the bending portion; and a buffering member to connect a main frame to which is connected the inserting portion and the frame unit, the buffering member absorbing external force applied to the inserting portion (see Fig. 18 and Col. 46, Line 40 - Col. 47, Line 67).

In regards to claim 15, Hibino et al. disclose an electric bending endoscope, wherein the operating portion is provided with a switch 505 for operating the electric bending endoscope (see Fig. 18).

In regards to claims 16 and 19, Hibino et al. disclose an electric bending endoscope wherein the unit comprises an inner frame for holding the motor and an outer frame for holding the inner frame (see Fig. 18).

In regards to claims 18 and 20, Hibino et al. disclose an electric bending endoscope comprising: a bending portion 508 arranged to an inserting portion 504; a first unit 663 which has a frame unit which holds a motor 686 that generates driving force for bending the bending portion; a second unit 503 which is separable from the first unit and which has a transmitting member 510 for transmitting the driving force of the motor to the bending portion, the second unit having a main frame to which is connected the inserting portion; and a buffering member to connect the main frame and the frame unit, the buffering member absorbing external force applied to the inserting portion (see Fig. 18 and Col. 46, Line 40 - Col. 47, Line 67).

In regard to claim 22, Hibino et al. disclose an electric bending endoscope, further comprising an operating portion connected to the first unit for operating the electric bending endoscope, wherein a wheel is arranged to a driving shaft of a driving force transmitting member of the second unit, and a rotating shaft of the wheel is arranged in front of the operating portion on a side cross-section of the operating portion in the electric bending endoscope, with respect to the central axis of the inserting portion (see Figs 1 and 34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-9 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 4,982,725 to Hibino et al. in view of U.S Patent No. 5,609,563 to Suzuki et al.

In regard to claims 8-9 and 23-24, Hibino et al. disclose an electric bending endoscope having an operation lever 16 arranged to the operating portion for operating the bending driving unit, but are silent with respect to an angle formed between the center axis of the inserting portion in the electric bending endoscope and the center axis of the operation lever at the neutral position thereof, and the angle is (120-150 degrees), an inclined angle of the operation lever is +/- 30 degrees from the center of the operation lever, and the inclined center position of the operation lever is arranged in

front of the operating portion, with respect to the center position of the inserting portion in the electric bending endoscope. Suzuki et al teach of an analogous electric bending endoscope wherein the operating portion of the endoscope is formed between the center axis of the inserting portion and the center axis of the operation lever as seen in Figs. 1 and 4. It would have been obvious to one skilled in the art at the time the invention was made to construct the operating portion of the apparatus of Hibino et al. at an angle in order to provide a more comfortable fitting during use for the operator of the instrument as taught by Suzuki et al.

Allowable Subject Matter

Claim 21 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed June 16, 2006 have been fully considered but they are not persuasive.

Applicant states that Hibino et al. fails to suggest that the first unit and second unit are separate. However, Hibino et al. clearly states that the second unit 503 of the endoscope 501 is removably connected to the first unit 663 (see Col. 46, Lines 48-52). Thus, Hibino et al. teaches of a second unit separable from the first unit, as claimed in the instant invention.

Applicant states that Hibino et al. fails to suggest a buffering member that absorbs external force applied to the inserting portion. However, as broadly as claimed,

the connecting portion (not shown in the figures) which removably connects the first unit 663 to the second unit 503 (see Col. 46, Lines 48-52) acts as buffering member, in a similar fashion to the instant invention wherein the connecting member 16 acts as a buffering member as clarified in the applicants arguments filed June 16, 2006 (page 7, line 11).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a buffer member that absorbs the force applied to the operating portion when the operation portion is operated) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK *ML*
9/20/06



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